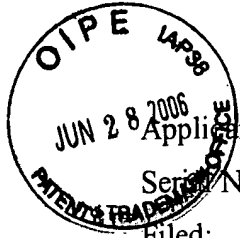


§ 1771
JUN 28 2006

Attorney Docket No. 32251-70829
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant: David C. May Confirmation No. 9351
Serial No.: 09/166,625 Art Unit: 1771
Filed: October 5, 1998 Examiner: Cheryl Ann Juska

For: HIGHLY DRAPABLE PROTECTIVE COVER HAVING ULTRATHIN
NON-WOVEN ABSORBENT LAYER

REQUEST FOR REHEARING (37 CFR § 41.52)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for rehearing of the decision of the Board of Patent Appeals and Interferences dated April 28, 2006. Reconsideration of the Board's decision based on the following points is requested.

Point No. 1. - The importance of 1-2 mil thickness.

The Board's decision at page 5 states, in part, "[i]n the present case, appellant has not attached any criticality to the claimed thickness, and the disclosed preference for the claimed thickness would seem to allay any suggestion of criticality...."

The claimed thickness of 1-2 mils is a critical feature of the present invention as demonstrated by Appellant's specification and appeal brief which urge the importance of the claimed thickness. For example, Appellant's specification at page 10 states

[t]he non-woven layer of the present invention preferably has a thickness in the range of 1-2 mils. The advantage of having a non-woven layer in the aforementioned thickness range is that the layer is thick enough to absorb and laterally disperse fluid it comes into contact with, but remains pliable enough to be very drapable."

Thus, appellant's preferred embodiment is of a thickness in the range of 1-2 mils. This statement emphasizes the importance of the 1-2 mil thickness recited in all of appellant's claims.

As noted above, all of the claims require a first layer thickness of 1-2 mils. The inclusion of this limitation in virtually all of the claims establishes the importance of this limitation.

Appellant's disclosure and brief discuss the physical properties of the drop cloth such that it is evident that the physical properties, including the 1-2 mil thickness, result in a drop cloth that is "light weight, absorbent, tear resistant, highly drapable" (appellant's specification, page 2, lines 18-19). Appellant's specification at, for example, page 2, states that "[t]hin plastic drop cloths have better draping characteristics but are prone to ripping and tearing and therefore are not suited for covering abrasive objects..." and thus supports the importance of the 1-2 mil limitation.

Appellant's brief also urges the importance of these features by stating,

[a]ppellant's disclosure repeatedly describes the importance of providing a drop cloth that is light-weight, resistant to tearing or puncturing is highly drapable and is absorbent. All of these features are important. How would replacement of Garland's spun bonded polypropylene with a 1-2 mil layer of nonwoven fabric including natural fibers (claim 1) or a 1-2 mil layer of nonwoven fabric including rayon fibers (claim 10) affect drapability, weight, absorbency, or tearing and puncture resistance? One of ordinary skill in the art would have had to consider all of these features, since simply making a more absorbent cloth is not the point. The point is making a drop cloth that has all of these important characteristics. (Brief at page 8.)

Thus, appellant's specification and brief demonstrate that all of the claimed features, including the thickness of 1-2 mil, are critical. It is the combination of features that result in the novel drop cloth. The prior art does disclose drop cloths. The prior art drop cloths do not teach or suggest a drop cloth having a first layer of 1-2 mil thickness that includes a non-woven fabric with natural (claim 1) or rayon (claim 10) fibers. This unique first layer in combination with the second layer provides the necessary drapability and also provides the necessary absorbency, tearing and puncture resistance. Providing a first layer higher than 1-2 mil would provide a less drapable and unacceptable drop cloth. Providing a first layer of less than 1-2 mil would provide an unacceptable less absorbent, less tear and less puncture resistant drop cloth.

It is submitted that the above-noted decision misapprehends the importance of the claimed 1-2 mil thickness.

Reconsideration based on the above remarks is requested.

Point No. 2. - The importance of natural or rayon fibers.

The Board's decision at page 3 acknowledges that "Garland does not disclose that his drop cloth includes natural or rayon in the non-woven fabric...." The decision goes on to state,

Garland, as well as Reaves and Trosper, evidences that it was known in the art to employ natural fibers, such as cotton, in the absorbent layer of a drop cloth... we are convinced that the examiner has properly concluded that it would have been obvious... to completely substitute natural fibers or rayon for the polypropylene of Garland in the non-woven fabric layer.

Even assuming arguendo that it would have been obvious to substitute natural fibers or rayon for the polypropylene of Garland in the non-woven fabric layer (and such is not conceded), the Board's decision does not explain how such substitution would result in a layer of 1-2 mil as recited in appellant's claim 1. Natural fibers are not the same as the polypropylene of Garland and even if the polypropylene of Garland were replaced by natural fibers or rayon in the non-woven fabric layer there is nothing to suggest that such could be achieved and still arrive at a 1-2 mil thickness as recited in appellant's claim 1. Claim 6 further emphasizes this feature wherein it is stated that the first layer has both natural fibers and synthetic fibers which are fused together. The decision does not explain, and it is not evident, how it would have been obvious to modify Garland to provide a layer of both natural fibers and synthetic fibers which are fused together and which has a 1-2 mil thickness. The decision fails to take into account that using different material (natural fiber, rayon or a combination) will provide a different thickness than what is taught by Garland. Once again, this is a key important and critical aspect of appellant's invention. Appellant has discovered that it is possible to use the stated materials and still limit the thickness to 1-2 mil. This is not taught or suggested by Garland.

Reconsideration based on the above remarks is requested.

Point No. 3. - Garland is non-enabling.

Appellant's brief at pages 5-6 states that

Garland states the drop cloth "preferably is made with a total thickness substantially in the range of 0.0015 to 0.004 mils" (column 4, lines 4-7). This is not even close to the range in appellant's claims and, at least for this reason, it cannot teach or suggest the claimed range. The office action argues that the 0.0015-0.004 mil range in Garland is in error even though Garland mentions these or similar dimensions repeatedly in columns 3, 4, 5 and 6. In view of the statement in the final office action that Garland's disclosure is not enabling on this point, then the rejection is not proper for the additional reason that Garland is not prior art.¹

The Board's decision notes that "the examiner has submitted extensive calculations to demonstrate that the disclosed thickness of Garland's non-woven layer is an obvious error, and that the non-woven layer of Garland actually 'has a thickness of 0.0005-0.002 inches or 0.5-2 mils' ... we will accept the examiner's calculations as reasonable."

The examiner also referred to three patents, as stated in appellant's brief,

[t]he office action continues by referencing three patents U.S. Patent No. 5,035,941 to Blackburn, U.S. Patent No. 4,704,323 to Duncan et al and U.S. Patent No. 4,441,228 to Marquart et al., citing their respective disclosures of spunbond polypropylene nonwoven of 13 mil thickness of 1.25 oz/yd², 8 mil thickness of 1.6 oz/yd² and 16 mil thickness and 2 oz/yd².

The three patents use the same spun bonded polypropylene as the layer in Garland whose thickness is discussed in the final office action. As noted above, the three patent disclosures (Blackburn, Duncan et al and Marquart et al.) teach thicknesses for the spun bonded polypropylene to be 13 mil (Blackburn, column 9, lines 6-8), 8 mil (Duncan et al., column 7, lines 12-14) and 16 mil (Marquart et al., column 4, lines 44-48). Thus, the three patents are evidence that one of ordinary skill in the art would know that the range of thickness for a spun bonded polypropylene layer can vary and would not have suspected that Garland's range is in error. Even if one of ordinary skill had suspected an error in Garland's range of 0.0005 to 0.002 mils they would not have calculated that Garland intended a 1-2 mil thickness based on a 1 to 2 ounce per square yard of spun bonded polypropylene because Blackburn, Duncan et al and

¹ Printed publication will not suffice as prior art if it was not enabling. See In re Donohue, 226 USPQ 619, 621 (Fed. Cir. 1985).

Marquart et al. are evidence that other quite different thicknesses are possible using a 1 to 2 ounce per square yard of spun bonded polypropylene. That is, Blackburn teaches a 13 mil thicknesses of a 1.25 oz/yd² of spun bonded polypropylene (Blackburn, column 9, lines 6-8), Duncan et al teaches an 8 mil thicknesses of spun bonded polypropylene at 1.6 oz/yd² (Duncan et al., column 7, lines 12-14) and Marquart et al. teaches a 16 mil thicknesses of spun bonded polypropylene at 2 oz/yd² (Marquart et al., column 4, lines 44-48). These three patents are evidence that the examiner's thickness calculation is an improper hindsight attempt to construe appellant's claimed range to be suggested by Garland. At best, Garland's disclosure on this point is non-enabling which disqualifies Garland as prior art.

The Board's decision does not speak directly to the issue of whether Garland is or is not enabling on this point. Garland's claims recite a thickness in the range of 0.0005 to 0.002 mils and in view of the Board's decision such claims appear to be invalid because as stated in the Board's decision "a layer of a drop cloth cannot realistically have a thickness of 0.0005 mils" (decision page 5). Garland, of course, is not represented in this matter, yet the decision casts doubt on the validity of the claims of Garland's unexpired patent. It is submitted that even if "a layer of a drop cloth cannot realistically have a thickness of 0.0005 mils" then Garland is not prior art on this point.

At page 5 the Board's decision states

it is well settled that where patentability is predicated upon a change in a condition of a prior art composition, such as a change in size... the burden is on the applicant to establish with objective evidence that the change is critical, i.e., leads to a new unexpected result... appellant has no attached any criticality to the claimed thickness....

The present claimed subject matter is not a "change in condition of a prior art composition." The claims recite, as explained above, a critical first layer of 1-2 mil thickness having a non-woven fabric material including natural (claim 1) or rayon (claim 10) fibers. There is no such composition in the prior art. The claimed first layer is novel because its' composition and thickness are unique and, as discussed above, using such layer with a second layer (as stated in the claims) provides a drop cloth of unique physical characteristics.

Reconsideration based on the above remarks is requested.

Point No. 4. - The Examiner's Official Notice re Claim 6.

The Board's decision at page 6 urges that

appellant has not properly challenged the examiner's official notice that 'it is well known in the art to employ a blend of synthetic thermoplastic fibers and cellulosic fibers to produce a strong nonwoven fabric being bonded by said thermoplastic fibers and to enhance the ability of the nonwoven [fabric] to bond to other thermoplastic materials.

The examiner's finding is not based on the citation of any prior art. It is submitted that it is proper to challenge a rejection that is not supported by any prior art evidence. The examiner's opinion stated in the form of official notice is not a proper prior art basis for the rejection of claim 6. Appellant's challenge afforded the examiner an opportunity to provide a proper prior art basis for what is alleged to be in the prior art. Appellant can properly evaluate prior art citations and determine what exactly is taught and suggested. The examiner's opinion is another matter altogether. The examiner, in effect, is stating that claim 6 is unpatentable without providing proper prior art support for the statement. The rejection is improper because it does not provide evidence of what is stated to be in the prior art.

Reconsideration based on the above remarks is requested.

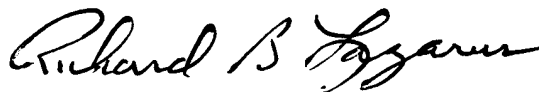
Conclusion

Reconsideration for the reasons noted above and for the reasons already of record is requested. For all of the reasons, reversal of the rejections of claims 1, 3-10 and 12-17 as stated in the August 25, 2004 final office action is requested.

It is respectfully requested that, if necessary, this paper be considered as a Petition for an Extension of Time and shortages in any fee, be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 (32251-70829).

Respectfully submitted,

BARNES & THORNBURG LLP



Richard B. Lazarus

Reg. No. 48,215

Tel. No. (202) 289-1313